

REMARKS

The Office Action mailed September 10, 2008 (hereinafter, "Office Action") has been reviewed and the Examiner's comments considered. Claims 25-59 are pending in this application. No amendments are made herein.

Claim Rejections - 35 U.S.C. § 103

Claims 25-30, 32-34, 36, 37, 41, 43, 44, 48 and 53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable by USPN 6,123,722 by Fogarty et al. (hereinafter, "Fogarty") as evidenced by USPN 5,741,327 by Frantzen (hereinafter, "Frantzen") in view of USPN 6,712,844 to Pacetti (hereinafter, "Pacetti"). Applicant respectfully traverses this rejection.

The Office Action alleges that Fogarty discloses the invention substantially as claimed, but admits that Fogarty does not disclose a conductivity-reducing oxide layer. The Office Action alleges that Frantzen teaches that an oxide layer forms on a nickel titanium stent when the stent is formed and that, therefore, the Fogarty stent includes a conductivity-reducing layer. Applicant disagrees with the initial conclusion in the Office Action that the teaching of Frantzen leads to a Fogarty stent with a conductivity-reducing oxide layer.

Applicant concedes that a person of ordinary skill in the art understands, as taught by Frantzen, that during some processing steps in the manufacture of nitinol stents, oxide layers form on the stent surface due to the steps being performed at (sometimes only locally) high temperatures in an oxidizing medium (mostly air). However, this same person also understands that the final processing steps in forming a stent are surface processing steps that remove the formed oxide layers through smoothing and polishing. Indeed, the removal of the oxide layers and the heat-affected zone beneath the oxide layers is intentional (as opposed to accidental from the polishing) due to the potential of corrosion and corrosion-related biocompatibility issues. Accordingly, to the extent that any oxide layer exists on the surface of the stent, it is so thin that it does not have a conductivity appreciably lower than that of the metallic nitinol. Moreover, in the subject passage, Frantzen describes the problematic nature of the oxide layers, such that further processing steps are described to enable the brazing of marker elements to the stent.

Accordingly, Applicant submits that the allegation that Fogarty evidenced by Frantzen forms the basis of a primary reference that discloses the invention substantially as claimed, but for the “order of magnitude” recitation, is without merit. Specifically, Applicant submits that Fogarty evidenced by Frantzen does not show or describe at least the claimed features of:

Independent claim 25: “. . . each bridge including a portion having a second electrical conductivity. . . lower than the first electrical conductivity, the bridges distributed throughout the length of the tubular structure and configured and arranged to divide the tubular structure into axially spaced and electrically insulated sections.”

Independent claim 44: “. . . furnishing said bridges between each ring and its adjacent ring with a portion having a second electrical conductivity. . . lower than the first electrical conductivity, the bridges distributed throughout the length of the tubular structure, arranged and configured to divide the tubular structure into axially spaced and electrically insulated sections.”

The Office Action further alleges that Pacetti teaches an oxide layer as an insulator that is substantially less conductive than adjacent conductive portions of the stent in order to enhance accurate MRI imaging. However, Pacetti does not show or describe each bridge including a second electrical conductivity at least an order of magnitude lower than the first electrical conductivity of each of the plurality of expandable rings. Instead, Pacetti is focused on the creation of discontinuities in the stent rings, disposed about the entire perimeter or circumference of the rings, or in particular cells defined by struts of the rings and connectors between rings. Pacetti, col. 6, ll. 31-35, 54-59. With respect to the connectors, Pacetti describes rings as being welded to one another, following creation of the discontinuities in the rings. Pacetti, col. 4, ll. 9-13. Further, Pacetti asserts that the number and configuration of the connectors “is not a significant aspect of the invention, and is a matter of choice for one of skill in the art.” Pacetti, col. 6, ll. 46-49, emphasis added. In addition to the discontinuities formed in the stent rings and cells, Pacetti mentions the possibility of formation in the connectors. Pacetti, col. 7, ll. 1-3. However, Pacetti teaches that preventing current flow between rings only is

insufficient, because the “rings themselves represent complete potential current paths that still impede meaningful imaging through MRI.” Pacetti, col. 3, ll. 1-4.

Accordingly, in view of the above, a *prima facie* case of obviousness is not established at least because the asserted combination of Fogarty/Frantzen/Pacetti does not show or describe all of the limitations in independent claims 25 and 44. Thus, independent claims 25 and 44, and claims 26-30, 32-34, 36, 37, 41, 43, 48 and 53 depending therefrom, are patentable over the asserted combination of Fogarty/Frantzen/Pacetti, and Applicant requests favorable reconsideration and withdrawal of this rejection under 35 U.S.C. § 103.

Claims 31, 38-40 and 42 stand rejected under 35 USC § 103(a) as being unpatentable over Fogarty in view of Pacetti, and further in view of Frantzen. Claims 35 and 49 stand rejected under 35 USC § 103(a) as being unpatentable over Fogarty in view of WO 99/43378 to Leonhardt. Claims 45-47 and 50-52 stand rejected under 35 USC § 103(a) as being unpatentable over Fogarty in view of Pacetti. Claims 54-59 stand rejected under 35 USC § 103(a) as being unpatentable over Fogarty in view of Pacetti and further in view of USPN 6,270,524 to Kim (hereinafter, “Kim”). Applicant respectfully traverses these rejections.

Without conceding the propriety of the asserted combinations, or the allegations contained in the Office Action, Applicant submits that each of the claims rejected under 35 U.S.C. § 103 depends from one of patentable independent claim 25 or claim 44, as discussed above, and is therefore patentable for at least this reason. Accordingly, Applicant requests favorable reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

It is noted that the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between the cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein should not be construed to prejudice or foreclose future consideration by Applicant of additional or alternative distinctions between the claims of the present application and the references cited by the Examiner and/or the merits of additional or alternative arguments.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 50-2191 referencing docket no. 1016710006P. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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